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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/895,381 | 07/02/2001 | Douglas C. Stahl | 2703.2 | 1421 |
| 5514 | 7590 | 01/21/2005 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | CLOW, LORI A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1631 | |
| DATE MAILED: 01/21/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/895,381

Applicant(s)

STAHL, DOUGLAS C.

Examiner

Lori A. Clow, Ph.D.

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 6 Januray 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1,3,5-13,15,17-25,27,29-37,39 and 41-48

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: See Continuation Sheet

Continuation of 3. Applicant's reply has overcome the following rejection(s): Applicant has clarified that the data comes from the amplification of nucleic acids such that identification of alleles is attained.

Continuation of 5. does NOT place the application in condition for allowance because: the claims, as written, are not enabled for distinguishing alleles from background using the recited steps.

Continuation of 10. Other: The Examiner appreciates Applicants attempt to overcome the outstanding 112, 1st paragraph rejections set forth in the previous Office Action. However, the rejection has not been fully overcome because it remains unclear exactly what nucleic acids are being amplified and therefore, the claims are not enabled. As previously set forth and as also recited in the prior art, it must be clear that the nucleic acids of interest have a correlation to a polymorphic region. In effort to guide Applicant for appropriate language concerning the nature of the nucleic acid, the Examiner again points to the specification at pages 13-14 which provide enablement for "amplifying alleles that exist in specific microsatellite marker locations of interest. The polymorphic markers are selected for determining genotype. Primers are designed to amplify the alleles of each marker". Again, the claims are now drawn to the amplification of nucleic acids, but the problem lies in the nature of the nucleic acid. Applicant is again reminded that the specification is enabling for the amplification of polymorphic DNA..

Sen A. Chow, Ph.D.
1/19/05

MARJORIE MORAN
PATENT EXAMINER

Marjorie A. Moran
1/19/05